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### REMARKS

By this paper, claims 1, 15, 29, 30-31 were amended. Presently, the application contains claims 1-32.

Even though it occurs after final rejection, this amendment is permissible because the Examiner agreed to consider them in a telephone interview conducted 6-1-2007.

Applicant requests favorable reconsideration and allowance of all pending claims for the reasons stated below.

### SUMMARY OF CHIEF ARGUMENTS

Without any intended limitation, some of Applicant's arguments are highlighted as follows.

1. The applied art does not show the claimed operations including, responsive to the user selecting an item from the search cart list, a browser navigating to a site associated with the selected item. Rather, Ehrlich's system is aimed at consummating a sales transaction, not navigating to sites. Indeed, Ehrlich says the its invention "enables the sale consummation directly from the shopping cart without having to visit the merchant's web sites."

2. The applied art does not show the claimed actions performed by a browser. Rather, Ehrlich's contains little or no disclosure related to a browser. Instead, Ehrlich's work is done by a central shopping cart manager 95, shopping cart engine 125, and other components of a virtual shopping cart system 10 that are sited in a host server 15 centrally located and clearly distinct from any web browsers of remote shoppers. [Ehrlich: Fig. 3A, ref. 335, 340; Fig. 1, ref. 15, 35, 37, 39; para. 0065]

3. Lacking the browser-performed actions as discussed above, the applied art *a fortiori* lacks the acts of modifying a browser to operate in a certain way (e.g., claim 31).

The foregoing summary provided in the interest of being helpful, and it is given without any intended limitation. Accordingly, expanded arguments are stated below.

**35 USC 103 REJECTIONS:  
CLAIMS 1-5, 7-12, 14-19, 21-26, 28-32**

These claims were rejected under 35 USC 103 as being unpatentable over the combination of U.S. Patent Document 2002/0156685 to Ehrlich et al. ("Ehrlich") in view of U.S. Patent Document 6,546,388 to Edlund et al. ("Edlund").

This rejection is respectfully traversed. The claims are patentable since a *prima facie* case of obviousness does not exist, as discussed in greater detail below.<sup>1</sup>

Teaching/Suggestion of Claim Limitations

Introduction

First, the *prima facie* obviousness case is incomplete because, even if the references were to be combined as suggested, the combination still does not teach or suggest all the claim limitations.<sup>2</sup>

Claim 1

As to claim 1 (as amended), Ehrlich-Edlund do not teach **"the browser adding a selection mechanism to the displayed results list, the selection mechanism programmed to receive user input identifying one or more items of search results from among the displayed results list."** Rather, Ehrlich's own words make it clear that Ehrlich is unrelated to any actions performed by a browser. In this regard, outside its background and definitions sections, Ehrlich only mentions a "browser" once (in para. 0080), in a context unrelated to the subject claim feature. Indeed, Ehrlich's work is done by a central shopping cart manager 95, shopping cart engine 125, and other components of a virtual shopping cart system 10 that are sited in a host server 15 centrally located and clearly distinct from any web browsers of remote shoppers. [Ehrlich: Fig. 3A,

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1 MPEP 2142.

2 MPEP 2142, 2143.03.

ref. 335, 340; Fig. 1, ref. 15, 35, 37, 39; para. 0065] Moreover, the office action recognized that Ehrlich does not teach a browser receiving a user's query and submitting the query to a search engine. [Office Action: page 10]

Thus, Ehrlich cannot be said to show "the browser..." adding a selection mechanism to the displayed results list, as claimed.

Ehrlich-Edlund further lack **"the browser displaying the search cart list and upon user selection of an identified item of search results from the displayed search cart list, navigating to a site associated with selected item directly from the displayed search cart list without the user having to operate the browser to navigate back to the displayed results list and choose the selected item of search results therefrom."** Again, Ehrlich is unrelated to any specific programming of a browser. Furthermore, regardless of which entity performs the claimed task, the task itself is missing from Ehrlich. To wit, the office action recognized that Ehrlich enables sale consummation directly from the shopping cart without having to visit the merchant's web sites. [Office Action: page 14] There is nothing in Ehrlich that discloses navigating to sites associated with the identified items of search results directly from the cart as claimed. Relatedly, Ehrlich is aimed at automating e-commerce transactions, not web surfing.

Ehrlich's para. 0027, by its own words, distinctly teach away from the claimed feature. Indeed, Ehrlich says the its invention "enables the sale consummation directly from the shopping cart without having to visit the merchant's web sites." Thus, it cannot be said that Ehrlich navigates to a site responsive to user selection of an identified item of search results from the displayed search cart list - - indeed, Ehrlich does the opposite ("... without having to visit the merchant's web sites.") [Ehrlich: para. 0027]

In view of the foregoing, the features of claim 1 are not taught by the applied art.

#### Claim 30

Independent claim 30 is distinguished for the same reasons expressed

above, and additionally as follows.

Chiefly, the applied art does not teach an **"enhanced search method operable in an environment where a browser receives a user's query and submits the query to a search engine, and the browser receives from the search engine a results list of at least one item of search results arising from the query, where each said item is associated with at least one site, and the browser further displays the results list"** as claimed.

The office action did not address this claim language, instead grouping its discussion of claim 30 with the discussion of claim 1. [Office Action: pages 2-3] However, claims 1 and 30 utilize different claim language. The office action did, however, acknowledge that Ehrlich does not teach a browser receiving a user's query and submitting the query to a search engine. [Office Action: page 10]

Yet, all words in a claim must be considered in judging the patentability of that claim against the prior art.<sup>3</sup> To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.<sup>4</sup>

Without more, the *prima facie* case of obviousness is not complete as to claim 30.

#### Claim 31

Claim 31 is patentable for the same reasons expressed above, and for some additional reasons:

The office action contended that Ehrlich teaches a "method for enhancing operation of a computer-implemented browser..." including an operation of "modifying the browser..." [Office Action: page 9] The office action pointed to

3 In re Wilson, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970). MPEP 2143.03.

4 Ex Parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). MPEP 706.02(j).

Ehrlich's paragraph 0115 in support of its contention. Para. 0115, however, merely contains boilerplate language stating that "numerous modifications may be made... without departing from the spirit..." [Ehrlich: para. 0115] There is nothing in para. 0115 to suggest or support enhancing a computer-implemented browser. In this sense, Ehrlich's para. 0115 fails to qualify as an enabling 35 USC 103 reference.

A reference itself must sufficiently describe the claimed invention to have placed the public in possession of it.<sup>5</sup> Even if a claimed invention is disclosed in a printed publication, that disclosure will not suffice as prior art if it was not enabling.<sup>6</sup> In order to anticipate, a prior art reference must be enabling, thus placing the allegedly disclosed subject matter in the possession of the public.<sup>7</sup> The reference must describe the applicant's claimed invention sufficiently to have placed a person of ordinary skill in the field of invention in possession of it.<sup>8</sup>

Ehrlich's boilerplate language fails to provide any meaningful disclosure pertaining to the claim language, and therefore fails as an enabling 35 USC 103 reference.

Importantly, a careful reading of the non-boilerplate text in the remainder of Ehrlich reveals that Ehrlich teaches away from the claim language. First, Ehrlich's disclosure does not contain any meaningful disclosure related to a browser. In this regard, outside its background and definitions sections, Ehrlich only mentions a "browser" once (in para. 0080), in a context unrelated to the subject claim feature. Indeed, Ehrlich's work is done by a central shopping cart manager 95, shopping cart engine 125, and other components of a virtual shopping cart system 10 that are sited in a host server 15 centrally located and

5 Paperless Accounting, Inc. v. Bay Area Rapid Transit System, 231 USPQ 649, 653 (Fed. Cir. 1986). Ex parte Gould, 231 USPQ 421 (CCPA 1973).

6 *Id.*

7 Akzo N.V. v. United States ITC, 808 F.2d 1471, 1 USPQ2d 1241 (Fed. Cir. 1986); Ashland Oil, Inc. v. Delta Resins & Refracs., Inc., 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985); Reading & Bates Constr. Co. v. Baker Energy Res. Corp., 748 F.2d 645, 223 USPQ 1168 (Fed. Cir. 1984)

8 In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990).

clearly distinct from any web browsers of remote shoppers. [Ehrlich: Fig. 3A, ref. 335, 340; Fig. 1, ref. 15, 35, 37, 39; para. 0065]

Therefore, as Ehrlich utilizes programming features central to many users instead of the fundamentally different approach of modifying users' web browsers, Ehrlich actually teaches away from a "method for enhancing operation of a computer-implemented browser..." including an operation of "modifying the browser..."

Accordingly, claim 31 is a *fortiori* distinguished from the applied art.

Claims 2-5, 7-12, 14, 15-19, 21-26, 28-29

For similar reasons as stated above, independent claims 15 and 29 are absent from the applied art. And, even without considering any individual merits of claims 2-5, 7-12, 14, 16-19, 21-26, and 28, these claims are distinguished from the applied art because they depend from independent claims that are distinguished as discussed above.<sup>9</sup>

Reason to Combine

Introduction

In addition to the reasons given above, the *prima facie* obviousness case is also defective because there has been no adequate showing of a reason that would have prompted an ordinarily skilled artisan to combine the elements in the way the claimed invention does.<sup>10</sup> The Supreme Court has recognized that a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.<sup>11</sup> The Supreme Court also recognized that, in this regard, helpful insight is available by considering whether there is any suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of

<sup>9</sup> If an independent claim is nonobvious under 35 USC 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). MPEP 2143.03.

<sup>10</sup> KSR International v. Teleflex, No. 04-1350, slip opinion, pp. 14-15 (U.S. Sup. Ct. April 30, 2007).

<sup>11</sup> KSR International v. Teleflex, No. 04-1350, slip op. at 14 (U.S. Sup. Ct. April 30, 2007).

ordinary skill in the art, to modify the reference or to combine reference teachings.<sup>12</sup> Furthermore, the Patent Office has acknowledged that, in formulating a rejection under section 103 based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.<sup>13</sup>

#### Analysis

The office action proposed adding Edlund's feature ("coupling to a search engine a graphical user interface for accepting keyword search terms..." from Edlund's Abstract) to Ehrlich for the following reason: to enable Ehrlich to conduct the following activity ("presenting to an end-user the intermediate matching search results of a keyword search in an index list of information...." from Edlund's Abstract). [Office Action: pages 3-4]

The argument for combining the references is unpersuasive for a number of reasons.

**1. First, the proposed Ehrlich-Edlund combination is improper because the references teach away from this combination.** Ehrlich's disclosure distances itself from previous approaches using search engines, characterizing them as inaccurate, inconvenient, and difficult. [Ehrlich: paras. 0016-0017] Ehrlich suggests that the state of the art does not adequately address shoppers' needs. [Ehrlich: para. 0020]

In this regard, Ehrlich proposes that customers should be able to browse any store, at any time, and be able to choose an item for a virtual shopping cart *and have any information available to that potential purchase retained for subsequent purchasing decisions.* [Ehrlich: para. 0021] Ehrlich proposes this "regardless of which shop or mall" that shoppers visit on the worldwide web.

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12 MPEP 2142.

13 USPTO memo from Margaret A. Focarino, Deputy Commissioner for Patent Operations, dated May 3, 2007.

[Ehrlich: para. 0021] Along these lines, Ehrlich further teaches away from the "brute force" solution of opening multiple instances of a browser and establishing connections between the client and multiple web sites. [Ehrlich: para. 0021] Hence, Ehrlich suggests using a web application server to handle requests from clients. [Ehrlich: para. 0030]

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.<sup>14</sup> Furthermore, it is improper to combine references where the references teach away from their combination.<sup>15</sup>

As Ehrlich teaches away from the proposed Ehrlich-Edlund combination, the reason for an ordinarily skilled artisan to make this combination is lacking.

**2. Second, the proposed Ehrlich-Edlund combination is improper because it would change Ehrlich's principle of operation.<sup>16</sup>** As discussed above, Ehrlich distances itself from prior approaches that use search engines. It is no surprise that, in subsequent paragraphs, Ehrlich's disclosure of its own invention proposes an entirely different structure that does not include any search engines. Indeed, Ehrlich employs a central shopping cart manager 95, shopping cart engine 125, and other components of a virtual shopping cart system 10 that are sited in a host server 15 centrally located and clearly distinct from any web browsers of remote shoppers. [Ehrlich: Fig. 3A, ref. 335, 340; Fig. 1, ref. 15, 35, 37, 39; para. 0065] Modifying Ehrlich to use Edlund's search engine approach would completely change the Ehrlich's principle of operation, requiring a substantial redesign and reconstruction of Ehrlich's elements.<sup>17</sup>

For these reasons, the *prima facie* case of obviousness is incomplete and

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<sup>14</sup> W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). MPEP 2141.02

<sup>15</sup> In re Graselli, 713 F.2d 731, 218 USPQ 769, 779 (Fed. Cir. 1983). MPEP 2145(4).

<sup>16</sup> In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). MPEP 2143.01.

<sup>17</sup> MPEP 2143.01.



claim 1 is patentable.

3. Third, in the absence of hindsight reconstruction, the rationale for combining Ehrlich with Edlund does not make sense. The office action proposed adding Edlund's feature ("coupling to a search engine a graphical user interface for accepting keyword search terms...") to Ehrlich. The rationale was to enable Ehrlich to "[present] to an end-user the intermediate matching search results of a keyword search in an index list of information...." [Office Action: pages 3-4] Nevertheless, the end product still does not explain why it would benefit Ehrlich to present to an end-user the intermediate matching search results of a keyword search. There has been no reasoning, in easy-to-understand terms, of any a real benefit. Further, the proposed benefit itself (Edlund's "intermediate matching search results") is vague, since Edlund only mentions it twice— in the Abstract and Summary. Edlund's specification or drawings contain no meaningful disclosure of this term.

Rather, the office action has cherry-picked features from Edlund's Abstract for addition to Ehrlich, in order to compensate for shortcoming in Ehrlich's disclosure. With nothing more, the Ehrlich-Edlund combination is merely the result of hindsight reconstruction.

However, it is improper to attempt to establish obviousness by using the applicant's specification as a guide to combining different prior art references to achieve the results of the claimed invention.<sup>18</sup> The teaching or suggestion to make the claimed combination must be found in the prior art, and not based on applicant's disclosure.<sup>19</sup> The critical inquiry is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.<sup>20</sup> Obviousness is tested by "what the combined

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18 Orthopedic Equipment Co., Inc. v. United States, 702 F.2d 1005, 1012, 217 USPQ 193, 199 (Fed. Cir. 1983).

19 In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

20 In re Fritch, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992) ("It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious."); *Fromson v. Advance Offset Plate*,

teachings of the references would have suggested to those of ordinary skill in the art."<sup>21</sup> But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination."<sup>22</sup> And "teachings of references can be combined only if there is some suggestion of incentive to do so."<sup>23</sup>

"To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher."<sup>24</sup> It is essential that "the decisionmaker forget what he or she has been taught at trial about the claimed invention and cast the mind back to the time the invention was made. . . to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art."<sup>25</sup>

The policy of the Patent and Trademark Office<sup>26</sup> is to follow in each and every case the standard of patentability enunciated by the Supreme Court in *Graham v. John Deere Co.*<sup>27</sup> As stated by the Supreme Court:

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Inc., 755 F.2d 1549, 1556, 225 USPQ 26, 31 (Fed. Cir. 1985) (nothing of record plainly indicated that it would have been obvious to combine previously separate lithography steps into one process). See e.g., *In re Gordon et al.*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (mere fact that prior art could be modified by turning apparatus upside down does not make modification obvious unless prior art suggests desirability of modification); *Ex Parte Kaiser*, 194 USPQ 47, 48 (Pat. Bd. of App. 1975) (Examiner's failure to indicate anywhere in the record his reason for finding alteration of reference to be obvious militates against rejection).

21 *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

22 *ACS Hosp. Sys. Inc. v. Montefiore Hosp.*, 32 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

23 *Id.*

24 *W. L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

25 *Id.*

26 MPEP 2141.

27 148 USPQ 459 (1966).

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or non-obviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.<sup>28</sup>

Thus, hindsight reconstruction, using the applicant's specification itself as a guide, is improper because it fails to consider the subject matter of the invention "as a whole" and fails to consider the invention as of the date at which the invention was made.

#### Resolving Level of Ordinary Skill

The office action's case is also incomplete because it does not resolve the level of ordinary skill in the pertinent art" as specifically required by the Supreme Court.<sup>29</sup>

The Court has emphasized that "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."<sup>30</sup> The Court required that analysis supporting a section 103 rejection should be made explicit.<sup>31</sup> Moreover, this analysis was made equally applicable to the courts and patent examiners.<sup>32</sup>

#### Conclusion

In conclusion, the *prima facie* obviousness case is incomplete because the office action does not provide a sufficient reason as to why one of ordinary

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28 148 USPQ at 467.

29 KSR International v. Teleflex, No. 04-1350, slip op. at 2 (U.S. Sup. Ct. April 30, 2007).

30 Id. at 14.

31 Id.

32 Id. at 2.

skill would have made the proposed combination of references.

#### Reasonable Expectation of Success

In addition to the reasons stated above, the *prima facie* obviousness case is also incomplete because the office action did not show that there would be a reasonable expectation of success in modifying/combining references.<sup>33</sup>

Critically, to establish a *prima facie* case of obviousness, there *must* be a reasonable expectation of success.<sup>34</sup>

Furthermore, an ordinarily skilled artisan would *not* enjoy reasonable prospects of success in combining Ehrlich with Edlund. As explained above in detail, Ehrlich and Edlund employ completely inconsistent approaches. Accordingly, since an ordinarily skilled artisan would not realize reasonable prospects of success in combining Ehrlich and Edlund, a *prima facie* case of obviousness is lacking.

#### Conclusion as to Claims 1-5, 7-12, 14-19, 21-26, 28-32

As shown above, then, these claims are patentable since a *prima facie* case of obviousness does not exist. Namely, (1) the applied art fails to teach the features of the claims, (2) there is no reason to combine references as proposed by the office action, and (3) there is no showing that an ordinarily skilled artisan would have a reasonable expectation of success in making the office action's proposed modification of references.

#### **35 USC 103 REJECTIONS** **CLAIMS 6 & 20**

These claims were rejected under 35 USC 103 as being unpatentable over the combination of Ehrlich, Edlund, and U.S. Patent Document 2003/0133076 to Lehmeier et al. ("Lehmeier").

Even without considering the individual merits of claims 6/20, they are

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33 MPEP 2142, 2143.02.

34 MPEP 2143.

patentably distinguished over the proposed combination because they depend from independent claims 1/15, which are allowable over Ehrlich-Edlund (as discussed above), and Lehmeier fails to provide the features missing from Ehrlich-Edlund. For instance, Lehmeier still does not show the claimed combination including features such as "the browser receiving..." or "the browser providing..." or "responsive to the browser receiving..." or "the browser displaying..." Indeed, the office action's reason for introducing Lehmeier was an attempt to show a different feature, namely a search cart in the form of a pull down or a side bar. [Office Action: page 11]

Accordingly, claims 6 and 20 are patentably distinguished from the applied art.

35 USC 103 REJECTIONS  
CLAIMS 13 & 27

These claims were rejected under 35 USC 103 as being unpatentable over the combination of Ehrlich, Edlund, and U.S. Patent No. 6,339,773 to Rishe.

Even without considering the individual merits of claims 13/27, they are patentably distinguished over the proposed combination because they depend from independent claims 1/15, which are allowable over Ehrlich-Edlund (as discussed above), and Rishe fails to provide the features missing from Ehrlich-Edlund. For instance, Rishe still does not show the claimed combination including features such as "the browser receiving..." or "the browser providing..." or "responsive to the browser receiving..." or "the browser displaying..." Indeed, the office action's reason for introducing Rishe was an attempt to show a different feature, namely, "responsive to receiving user designation of selected entries within said search cart list, transferring said selected entries to a nonvolatile bookmarks list..." [Office Action: page 12]

Accordingly, claims 13 and 27 are patentably distinguished from the applied art.

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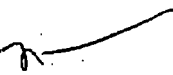
CONCLUSION

In view of the foregoing, all pending claims in the application are patentable over the applied art.

FEES

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Michael Glenn  
Reg. No. 30,176

Customer No. 22,862